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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,220	11/09/2001	Chc-Kun James Shen	514162000120	5165
20872	7590	11/03/2004	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			KAUSHAL, SUMESH	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/014,220

Applicant(s)

SHEN, CHE-KUN JAMES

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1636

DETAILED ACTION

Applicant's response filed on 08/18/04 has been acknowledged.

Claims 1-20 are canceled.

Claims 21-34 are pending and are examined in this office action.

Applicants are required to follow Amendment Practice under revised 37 CFR §1.121. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/18/04 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1636

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14 of U.S. Patent No. 6,303,845. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of isolated animal cells that contains a transgene comprising a promoter operatively linked to the enhancer comprising the sequences of SEQ ID NO:1 (tctgagtca) encompasses the isolated cells as claimed in US '845.

The scope of claims 21-34 of instant application encompasses isolated animal cells and progeny thereof whose genomic DNA comprises at least one copy of chromosomally integrated transgene comprising (1) a transcriptional start site (2) a promoter operably linked to the transcriptional start site and (3) an enhancer operably linked to the promoter (ζ -globin promoter), the enhancer comprises the nucleotide sequences of SEQ ID NO:1, 2 or 3, wherein the cell express transcripts driven by the promoter the level of expression being positively correlated with the copy number of the transgene (5-15 copies).

The scope of invention claimed in US '845 encompasses an isolated cell whose genomic DNA comprises at least one copy of a transgene comprising (1) a nucleic acid sequence encoding a polypeptide; (2) a ζ -globin promoter operably linked to the nucleic acid sequence; and (3) an enhancer operably linked to the promoter, the enhancer comprising the nucleotide sequence of SEQ ID NO:1, 2 or 3, wherein the cell expresses the polypeptide, the level of expression being correlated with the copy number of the transgene (5-15 copies).

Art Unit: 1636

Furthermore the nucleic acid sequences of enhancer regions of SEQ ID NO:1, 2 and 3 as claimed in the instant application are identical to nucleic acid sequences of enhancer regions of SEQ ID NO:1, 2 and 3 of US'845.

Thus it would have been obvious to one ordinary skill in the art at the time of filing to modify the invention of US '845 by modifying the transgene to contain a nucleic acid sequence that encodes a growth hormone polypeptide. It would have been further obvious to substitute the isolated animal cell of US '845 with an isolated pig, rat, cow, rabbit, goat, guinea pig, prairie baboon, squirrel, monkey, chimpanzee, bird, frog, toad, chicken, turkey or a sheep cell. One would have a reasonable expectation of success in doing so, since modification of a transgene in order to express a protein of interest (i.e. growth hormone) in any kind of animal cell (i.e. pig, rat, cow, rabbit, goat, guinea pig, prairie baboon, squirrel, monkey, chimpanzee, bird, frog, toad, chicken, turkey or a sheep) has been routine in the art at the time the instant invention was filed. Thus the invention as claimed in the instant application is prima facie obvious in view of invention claimed in US'845.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 571-272-0769. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 571-272-0781.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight

Art Unit: 1636

(EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Sumesh Kaushal
Examiner GAU 1636



SUMESH KAUSHAL
PATENT EXAMINER